

REMARKS

The Final Action of April 29, 2010 substantially repeated the rejections under 35 U.S.C. §102 of the previous office action, and set forth that applicant's arguments with respect to such rejections were not found to be persuasive. However, from the comments by the Examiner with respect to applicant's previous arguments, it appears that the Examiner did not fully understand applicant's arguments, and therefore this Request for Reconsideration is being filed to clarify these arguments in the hope that an Appeal can thus be avoided.

This application is being submitted for reconsideration without any amendments, except for amending claims 15 and 16 so as to depend from claim 13, rather than from claim 14, since claim 14 had been cancelled and its subject matter included in claim 13 in the response to the previous official action.

Since the final rejections of all the claims were based on 35 U.S.C. §102, it perhaps will be helpful to set forth the requirements for such a rejection under this Section of the Patents Law.

The propriety of a rejection under 35 U.S.C. §102 has been clearly established by many Court decisions; see, example, the following quotation from American Permahedge Inc. v. Barcana, Inc. 32 USPQ2d 1901 (at Pages 1807–1808):

“Prior art anticipates an invention, rendering it invalid, pursuant to 35 U.S.C. §102, if a single prior art reference contains each and every element of the patent at issue, operating in the same fashion to perform the identical function as the patented product. *Scripps Clinic & Research Found v. Genentech, Inc.*, 927 F.2d 1565, 1576 [18 USPQ2d 1001] (Fed.Cir.1991); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d at 138. ‘There must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention.’ *Scripps Clinic & Research Found v. Genentech, Inc.*, 927 F. 2d at 1576; see also *E.I. Du Pont Nemours & Co. v. Polaroid Graphics Imaging, Inc.*, 706 F.Supp. 1135, 1142 [10 USPQ2d 1579] (D. Del 1989), *aff’d*, 887 F.2d 1095 [13 USPQ2d 1731] (Fed. Cir. 1989) (‘all of the same elements [must be] found in exactly the same situation and united in the same way ... in a single prior art reference’) (quoting *Perkin Elmer Corp. v. Computervision, Corp.*, 732 F.2d 888, 894 [221 USPQ 669] (Fed. Cir. 1984). Thus, any degree of physical difference between the patented production and the prior art, no matter how slight, defeats the claim of anticipation. *E.I. Du Pont de Nemours & Co. v. Polaroid Graphics Imaging, Inc.*, 706 F.Supp. At 1142”

As will be shown below, none of the rejections under 35 U.S.C. §102 is supported by the above holdings established by many prior Court decisions.

Thus, independent claim 1, as well as many of its dependent claims, were rejected under 35 U.S.C. §102(b) as being anticipated by Furusawa US Patent Application Publication 2001/0041901. As pointed in the previous response, independent claim 1 was submitted to clearly distinguish over this patent publication by the following recitation at the end of claim 1:

“characterized in that said distal end of the elongated shaft is formed with an open slot starting from a location spaced from said end face and extending along the outer surface of the elongated shaft to said recess in said end face, such as to enable the knotted suture to be introduced into the slot and the recess by effecting a sidewise movement of the knotted suture with respect to the elongated shaft, or vice-versa; and in that said open slot is formed with a first section leading from said recess towards said proximal end of the elongated shaft, and a second section leading from a juncture with said first section back towards said distal end of the elongated shaft but terminating short of, and proximal to, said end face; said second section of the open slot decreasing in width from said juncture to its end terminating short of said end face.” (underlining added).

The foregoing recitation is clearly supported by the original description in the specification, for example on Page 10, lines 2–4, reading as follows:

“As seen in Figs. 5 and 6, the width of each slot section 133a, 133b gradually decreases from the juncture 133c of the two sections towards the distal end of the elongated shaft.”

This is clearly seen in the drawings, for example Figs. 5 and 6, wherein slot section 133a (the first section) gradually decreases in width from the juncture 133c to the distal end 134 of the elongated shaft, and similarly slot section 133b (the second section) gradually decreases in width from the juncture to its end terminating short of the end face 134.

To support the Examiner’s holding that this feature is met by the cited reference, the Examiner refers to the annotated figure attached to the previous action as showing that:

“the second slot section C extending back toward the distal end from the juncture B and decreasing it (in) size” (Section I, Page 2 of the Official Action).

It is interesting to note that the Examiner uses the word “size” rather than “width”, since by no stretch of the imagination could Section C of the figure referred to by the Examiner be considered as:

“decreasing in width from said juncture to its end terminating short of said end face”.

If anything, slot section 3 increases in width, rather than decreases in width, from the juncture B to its end terminating short of the end face. This difference between the two structures is very significant in view of the different manners in which each structure operates to perform its respective function.

Clearly, therefore, the rejection of claim 1 under 35 U.S.C. §102 as being anticipated by the cited Furusawa patent publication is not supported by the above-quoted decisions.

Claims 2 and 4–8, rejected on the same grounds under 35 U.S.C. §102, all depend from claim 1, and are therefore also allowable with claim 1 for the reasons set forth above. However, many of these claims include further features distinguishing over the cited reference, which further support their allowance.

For example, claim 4 sets forth the additional feature that the first slot section 133a is formed in a plane at an angle of 10–30 degrees relative to the longitudinal axis of the elongated shaft. For this feature, the Examiner comments, middle of Page 4:

“section A is a three dimensional object and hence has an infinite amount of plane, one of which is in a plane at an angle of 10–30 degrees relative to the longitudinal axis. Such second slot section C additionally comprises a plane parallel to the longitudinal axis of the elongated shaft (Fig. 19C).”

This statement by the Examiner further shows the unreasonable construction given by the Examiner to language in the claims in an attempt to “read” the claim on the prior reference, and would hardly meet the requirement for a proper 35 U.S.C. §102 rejection as set forth above:

“There must be no difference between the claimed invention and referenced disclosure, as viewed by a person of ordinary skill in the field of the invention.”

One skilled in this field would hardly consider that the Examiner’s statement as quoted above justifies the rejection of claim 4 under 35 U.S.C. §102.

Claim 5 also depends on claim 1, and claim 6 adds the further feature that the second slot section (133b) is formed in a plane parallel to the longitudinal axis of the elongated shaft. In the cited reference, it is the first slot section 4 (identified as A in the Examiner’s sketch), and not the second slot section 5 (identified as C in the Examiner’s sketch) which is substantially parallel to the longitudinal axis of the shaft.

Claim 6, dependent on claim 5, adds the further feature of claim 4, discussed and distinguished above.

Claim 7, which depends on claim 6, adds the further feature that the width of the first slot section (133a) also (i.e., in addition to the second slot section 133b) gradually decreases from the juncture (133c) towards the recess in the end face of the distal end of the elongated shaft. However, in the cited reference the first slot section 4 (identified at A) increases in width (rather than decreases in width) from the juncture (B) toward the recess in the end face of the distal end of the elongated shaft.

It is submitted, therefore, that claim 7, together with claim 8 which depends from claim 7, is allowable over the cited reference under 35 U.S.C. §102 for the foregoing feature, apart from the features set forth in claim 1 as discussed above.

Claims 8–12 all depend from claim 1 (or one of the other claims depending from claim 1), and are therefore submitted to be allowable with claim 1 for the reasons discussed above, apart from the further feature included in the respective dependent claims.

Independent claim 13 is patterned after independent claim 1, and includes the same distinguishing features appearing in claim 1 as quoted above. Claim 13, therefore, is submitted also to be allowable for the same reasons as discussed above with respect to claim 1.

Regarding the remaining claims 15–20, as indicated above claims 15 and 16 have been amended merely to correct their dependency on claim 13, rather than on claim 14

which was cancelled in the response to the previous office action. Since claims 15–20 now depend from claim 13, it is submitted that they are also allowable with claim 13 for the same reasons as discussed above with respect to claim 1 and its dependent claims.

In view of the foregoing, it is believed this application is now in condition for allowance, and an early Notice of Allowance is therefore respectfully requested.

If, however, the Examiner is still of the opinion that the application, with the above amendments to claims 15 and 16, is still not allowable, it is respectfully requested that the amendments to these claims be entered for purposes of appeal since, as indicated above, they merely correct what is a clearly inadvertent error and certainly do not raise any new issues or require any further search.

Since the application is under Final, an early action is particularly solicited.

Respectfully submitted,

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